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| 09/270,710 | 03/16/1999 | LAWRENCE F. GLASER | 740388-20 | 2842 |
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| <div>07/14/2009</div> | | | | |
| <div>EXAMINER RETTA, YEHDEGA</div> | | | | |
| <div>ART UNIT 3622</div> | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/270,710

Applicant(s)

GLASER, LAWRENCE F.

Examiner

Yehdega Retta

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27, 28, 31-36 and 38-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 28, 31-36 and 38-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

This office action in response to amendment/remarks filed March 20, 2009. Applicant amended claims. Claims 27, 28, 31-36 and 38-49 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 35, 36, 41-43 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al. (US 6,510,453) in view of "Tuning to the Internet", Harris, Kellee; Sporting Goods Business, San Francisco, Nov, 1995, Vol. 28, Iss.11 pg 15 (hereinafter Harris) and further in view of Pirani (US 5,105,184).

Regarding claims 27, 35, 36, 41-43 and 48, Apfel teaches identifying a user of the data processing system, said identified user being the identified sending party; initiating an e-mail communication from the data processing system of the identified sending party; embedding at least one pre-selected message associated with the identified sending party in said communication, and transmitting the e-mail communication with the at least one message associated with the identified sending party (see col. 3 line 6 to col. 4 line 16, col. 8 lines 28-64, fig. 3-6). Apfel does not teach the embedding is for advertisement, wherein said advertisement is for hardware installed on the data processing system by said identified sending party. Harris teaches e-mail signature including advertising materials describing products or services. Pirani

teaches advertisement for hardware installed on the data processing system of a user; embedding the pre-selected advertisement associated with a software; wherein the embedding is done with the data processing system of the user (integration of advertisement with software); the advertisement automatically embedded by a third party, (see col. 1 lines 44-64, col. 2 lines 53-60, col. 3 line 55 to col. 4 line 44). Pirani teaches integration of commercial advertisements with software by the data processing system of the user to provide additional funds to the software manufacturers and increase the availability of software to the user at low cost. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate an advertisement as in Harris by automatically embedding the advertisement by the data processing system of the user for the software or hardware installed on the data processing as in Pirani in order to increase the availability of the particular software or hardware, as taught in Pirani (see col. 2 lines 53-60).

Claims 28, 31-34, 38-40, 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apfel et al. (US 6,510,453), in view of Harris, in view of Pirani and further in view of Markwitz (US 5,513,254

Regarding claims 28, 34, 38 Apfel/Harris/Pirani does not teach offering to a user an option of becoming an advertiser; if the offer is accepted the user being compensated for it, it is taught in Markwitz (see col. 2 lines 1-11, col. 4 lines 22-36, and col. 5 lines 4-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide option for the user to include advertisement of products or service for compensation, as in Markwitz, in order to be compensated.

Regarding claims 31-33, 40, Apfel/Harris/Pirani does not teach the advertisement is automatically sent for a pre-selected time period and a pre-selected number of times, it is taught in Markwitz (see col. 3 line 31 to col. 4 line 9, col. 6 lines 20-33). It would have been obvious to one of ordinary skill in the art to change the advertisement in the email in order to provide different advertisements for a product or for different products, as taught in Markwitz.

Regarding claim 39, Apfel/Harris/Pirani does not but Markwitz teaches including fraud avoidance means for reducing or eliminating fraud (see col. 5 lines 4-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to include fraud avoidance means to make sure the advertisement is included in the communication system so that only those who provide the advertisement are compensated.

Regarding claim 46, Apfel does not but Harris teaches embedding a personal testimonial by the sending party. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a personal testimonial as in Harris to verify that the information is something that the sender has approved.

Regarding claims 44 and 45, Apfel/Harris/Pirani does not but Markowitz teaches the advertisement is automatically determined at least in part by the recipient's profile (see col. 6 lines 20-33), but failed to explicitly teach that the profile includes demographic data such as gender, age, income, etc. Official notice is taken that is old and well known in the art at the time of the invention to know that customer profiles include demographic data such as age, income etc, for the intended purpose of providing targeted advertisement based on the demographic data.

Response to Arguments

Applicant's arguments filed March 20, 2009 have been fully considered but they are not persuasive. Applicant argues that nowhere in Pirani is there a disclosure that any advertisement should be related to any hardware whatsoever. Applicant also argues that Apfel, Harris and Pirani, either alone or in combination, do not teach or suggest ***automatically embedding*** at least one pre-selected advertisement associated with an identified sending party in communication, wherein the advertisement is for hardware installed on the data processing system by the identified sending party.

Examiner would like to point out that the claim does not recite "automatically embedding at least one pre-selected advertisement". The claim recites embedding at least one pre-selected advertisement, said *embedding being done with the data processing system* of the sending party.

Apfel teaches electronic mail signature can be inserting (embedding) into an electronic mail message without manual intervention (with the data processing system i.e. the computer or software within the computer) (see, for example, col. 3 lines 30-42, col. 4 lines 62-67)

Harris also teaches that the signature carrying the senders name, company name, mail address, URL/web page address and a one-line marketing tagline describing a product or service can be set up *by the Internet service provider* or sender can manually add it at the end of each message. Also in Harris the "data processing system" (computer or Software within the computer) embeds (insert) the marketing message in the signature of the email. Examiner is aware that both Apfel and Harris do not teach the marketing data is for hardware installed on the data processing system. Pirani teaches *advertisement for software* installed on the data processing system. Even though Pirani does not explicitly teach the advertisement being for a

hardware, it would have been obvious to one of ordinary skill in the art at the time of the invention to advertise for a computer hardware or software that is installed in the computer since most hardware installed in the computer also require a software to interact with the hardware.

Applicant's specification (page 13-14) teaches in a more preferred embodiment of the present invention, the advertisement is related to particular software or hardware that is being used by the data processing system from which the e-message 1 was generated. The specification further teaches when the software or hardware is installed, the installation program will offer the user of the system an option to become an advertiser *the installation program will make appropriate modifications to the user's computer system so that appropriate advertisements are sent with electronic communications originating from the computer system* in the manner herein described:

If the user decides to become an advertiser, i.e. participate, then at step 250 the mouse setup procedure queries the computer system to determine the type, and/or version of e-mail client that is being used on that particular platform. Based on the results of the query in step 250, the setup procedure properly links or correlates a particular advertisement, preferably associated with the mouse product or manufacturer with e-mail generation and transmission. In one embodiment of the present invention, the setup procedure merely includes a textual advertisement in the default signature area of the e-mail client. That is, the setup program modifies the existing default signature for the e-mail client to include a suitable advertisement. In the event that the user already includes a signature having, for example, his name and address, then such advertisement would be added to this information and placed directly below this user information.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622